

REMARKS/ARGUMENTS

Applicants have reviewed and considered the Final Office Action mailed on April 9, 2009, and the reference cited therewith. Claims 1-4, 6, 8-22, and 25 are currently pending in the application. Applicants amend Claim 6 to correct a lack of antecedent basis. No new matter is being introduced by way of the amendments. Reconsideration and allowance of all pending claims are respectfully requested in view of the following remarks.

Rejections under 35 U.S.C. § 103

Claims 1-4, 6, 10-14, 16-22, and 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Staples et al. (U.S. Publication No. 2002/0118671) (hereinafter "Staples") in view of Smith et al. (U.S. Publication No. 2003/0018916) (hereinafter "Smith"). Applicants respectfully traverse this rejection.

Standard

The Examiner bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. §103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). When evaluating claims for obviousness under 35 U.S.C. 103, all the limitations of the claims must be considered and given weight. *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983) *aff'd* mem. 738 F.2d 453 (Fed. Cir. 1984). In other words, all words in a claim must be considered in judging the patentability of that claim against the prior art. MPEP § 2143.03 (emphasis added). Further, rejections based on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Teleflex Inc. v. KSR Int'l Co.*, 550 U.S. at 1, 82 USPQ2d at 1396 (2007).

The Combination of the References Does Not Disclose or Suggest All Limitations of the Claims.

The office action fails to establish a *prima facie* case of obviousness against Claim 1 because the combination of the cited references does not appear to disclose or even suggest all the limitations recited in Claim 1. For example, Claim 1 recites "an in-band access path defined by a communication path between the user computing device and the remote network element via said

first network, firewall, and router” and “an out-of-band access path defined by a communication path between the user computing device and the remote network element via said first network, firewall, first server, modem bank, and PSTN.” In other words, Claim 1 recites two separate communication paths (an in band path and an out of band path) between a user’s computing device and a remote network element (as depicted in Figure 2B). One advantage of the invention recited in Claim 1 is to provide a secondary line of service for enabling communication with remote elements within the service provider’s management and operations facility in case the first communication path is down. (See, Specification, par. [0033]).

The office action relies on Staples’ disclosure for disclosing the recited elements of a first network, firewall, router, first server, and PSTN. Even if, arguendo, Staples discloses these recited elements, which Applicants disagree, Staples does not disclose two communication paths between a user’s computing device and a remote network element as recited in Claim 1. For instance, in the Examiner’s response to the prior submitted arguments, the Examiner states that “Staples teaches a user computing device (element 130/112) communicating with a remote network element (element 110, 161A, and 161B).” Final Office Action dated April 9, 2009, p. 2. The office action further relies on Staples’ Figure 6 for illustrating the connection between a user computing device (element 130/112) and remote elements 110, 161A, and 161B. Staples’ Figure 6 is depicted below:

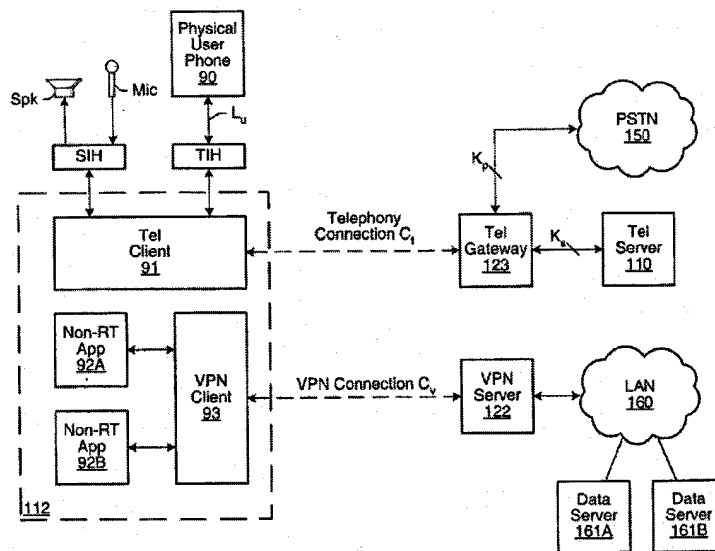


Fig. 6

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As depicted above, Staples illustrates a user computing device (element 112) in communication network elements 110, 161A, and 161B as stated by the Examiner. For instance, Staples appears to provide an in-band connection (VPN connection C_v) between computing device 112 and data servers 161A and 161B. Staples also appears to provide an out-of band connection (Telephony connection C_T) between computing device 112 and telephone server 110. However, Staples clearly does not provide both an in-band connection and an out-of band connection between a computing device and the same network element, whether it be element 110, 161A, or 161B. Even in the response to arguments section, on page 2 of the Final Office Action, the Examiner fails to refer to a specific remote element that communicates with a user's computing device over both an in-band connection and an out-of band connection.

Further, Claim 1 recites other limitations not disclosed or suggested by the combination of the cited references. For example, Claim 1 recites "a firewall in communication with said first network and configured to restrict access to said first network and the user computing device" (emphasis added). Staples appears to disclose a firewall 121 in Figure 4. However, firewall 121 restricts access to local area network (LAN) 160 (i.e., the office environment in Figure. 3A) and not to the user computing device as recited in Claim 1. (See, Staples, par. [0409], "Firewall 121 provides LAN 160 with a controlled connection to the Internet 125.")

For at least the above stated reasons, the office action fails to establish a *prima facie* case of obviousness against Claim 1.

The Prior Art Must Be Considered In Its Entirety, Including Disclosures That Teach Away From the Claims.

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). MPEP, § 2141.02.

The office action relies on a combination of Staples and Smith for rejecting Claim 1 under 35 U.S.C. § 103. In particular, the office action on pages 4-5 states:

Staples does not explicitly disclose a modem bank connected to a plurality of modems operable to authenticate the request and communicate. However, Smith discloses a modem bank connected to a plurality of modems that authenticates

and provides a connection to remote elements (page 2, paragraph 16). Staples and Smith are analogous art because they are from the same field of endeavor, networks. At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Staples and Smith before him or her, to modify the system of Staples to include the modem bank of Smith. The suggestion/motivation for doing so would have been that traditional phone connections incur significant costs on each side of the carrier (page 2, paragraph 16).

In the above cited portion, the proffered suggestion/motivation for combining the "modem bank," disclosed in Smith, to Staples' disclosure is that traditional phone connections incur significant costs on each side of the carrier (Smith, page 2, paragraph 16). However, the proffered suggestion/motivation is taken out of context. When taken in its entirety, Smith clearly teaches away from the use of a modem bank. For instance, Smith states the following:

[0016] Such a phone connection incurs significant cost at the local equipment company on each side of the connection, as well as at the interexchange carrier trunk level. Also, the terminating RAS device and the connection between the terminating RAS device and the destination computer system must be maintained and managed at some expense. One option is for a company or other organization to maintain a modem bank with supporting computer equipment and staff that enable receipt of calls via the modem 111 and authenticate users before connecting them to the destination computer at 112. Alternatively, such an organization can make use of a dial-in service which maintains modems for dial-in access, and that then provides a connection via a public network such as the Internet 119 to the destination computer 112. Both options involve paying long distance phone charges through a remote or destination local exchange company (LEC), and require extensive staff and equipment to provide a secure connection over a public network or to operate a phone bank.

[0017] Also, the client device 101 typically must have some type of encryption software installed and configured to support secure communication over a public network 119, which adds software and support expense to the dial-in client as well as to the destination. The present invention addresses some of these problems and other problems, and provides secure dial-in access to an enterprise system over a public network via a Virtual Secure Point of Presence (VSPOP).

Smith, pars. [0016]-[0017] (emphasis added).

As shown above, when taken in its entirety, Smith clearly teaches away from the use of a modem bank. For instance, Smith states that using a modem bank would involve paying long distance phone charges, require extensive staff and equipment to provide a secure connection over a

public network, and client devices must include expensive software installed. Smith's invention appears to address these problems associated with the use of a modem bank. In fact, the remaining disclosure of Smith is devoid of any reference to using a modem bank. Accordingly, when taken in its entirety, Smith clearly teaches away from the use of a modem bank. Thus, one of ordinary skill in the art would not have combined the Smith reference with Staples in coming up with the claimed invention. Consequently, the office action fails to provide an articulated reasoning with some rational underpinning to support the legal conclusion of obviousness as necessitated under KSR. Therefore, for at least this additional reason, the office action fails to establish a *prima facie* case of obviousness against Claim 1.

Claims 2-4, 6, 10-14, 16-22, and 25

Independent Claim 6 includes the features of "communicating between a user computing device and a network element via an in-band access path, the in-band access path including a firewall and router" and "communicating between the user computing device and the network element via an out-of-band access path, the out-of-band access path including the firewall, a first server, a modem bank, and a public switched telephone network." For analogous reasons as those discussed with respect to Independent Claim 1, Applicants respectfully submit that the office action fails to establish a *prima facie* case of obviousness against Claim 6.

Independent Claim 11 includes "One or more computer-readable storage media having computer-useable instructions embodied thereon, the instructions, when executed on a computing device, cause the computing device to: receive a first request via an out-of-band process to establish a communications pathway with a network device." For analogous reasons as those discussed with respect to Independent Claim 1, Applicants respectfully submit that the office action fails to establish a *prima facie* case of obviousness against Claim 11.

Claims 2-4, 8-10, 12-16-22, and 25 are dependent upon and include the features of their respective Independent Claims 1, 6, and 11. For at least the reasons discussed with respect to Independent Claims 1, 6, and 11, Applicants respectfully submit that Claims 2-4, 10, 12-14, 16-22, and 25 are allowable over the cited references and request that the 35 U.S.C. 103(a) rejections of Claims 2-4, 10, 12-14, 16-22, and 25 be withdrawn.

CONCLUSION

For the foregoing reasons, and for other apparent reasons, Applicants respectfully request reconsideration and favorable action. If the Examiner feels a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stand ready to conduct such a conference at the convenience of the Examiner.

Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 19-3140, under Docket No. 11000060-0043, of Sonnenschein Nath & Rosenthal LLP from which the undersigned is authorized to draw.

Dated: May 22, 2009

Respectfully submitted,

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